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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 673,292	10 13 2000	Denise L. Faustman	MGH-002.1 PUS	5350

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EXAMINER
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WEHBE, ANNE MARIE SABRINA

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 07/30/2003

*C.*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/673,292

Applicant(s)

Faustman

Examiner

Anne Marie Wehbé

Art Unit

1632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 27, 2002
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are a) \_\_\_\_\_ accepted or b) \_\_\_\_\_ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) \_\_\_\_\_ approved b) \_\_\_\_\_ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some\* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

- a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and or 121.

## Attachment(s)

- |   |  |
|---|--|
| 1. Notice of References Cited (PTO 892)                         | 4. Interview Summary (PTO 413, Paper No. _____)    |
| 2. Failure to Transparencize Patent Application (PTO 893)       | 5. Failure to Transparencize Application (PTO 894) |
| 3. Information Disclosure Statement (PTO 1449, Paper No. _____) | 6. Other _____                                     |

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***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, and 31-32, drawn to nucleic acids, vectors encoding said nucleic acids, host cells transformed with said vectors, methods of producing polypeptides using said host cells, and methods of altering peptide transport in a cell using said nucleic acids, classified in classes 536, 435, and 514, subclasses 23.1, 320.1 and 325, and 44.
- II. Claims 24-28, drawn to polypeptides, classified in class 530, subclasses 300 and 350.
- III. Claims 29-30, drawn to antibodies, classified in class 530, subclass 387.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related in part as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the polypeptides of invention II can be made by using an amino acid synthesizer, or by isolating said naturally occurring polypeptides from human cells.

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Inventions I-III are further patentably distinct in that the nucleic acids, vectors and host cells of invention I, the polypeptides of invention II, and the antibodies of invention III have substantially different structures and properties, are made using substantially different techniques, have different modes of operation, different functions, and different effects, and can be used for substantially different purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie S. Beckerleg, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Mon-Thurs and every other Friday from 8:30-6:00. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The official fax number is (703) 308-4242.

Dr. A.M.S. Beckerleg

ANNE M. WEHBE' PH.D  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Anne M. Wehbe', with a stylized flourish at the end.